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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,774	10/03/2005	Ian Robert Wheeler	860576.00002	4722
26710 7590 07/02/2008 QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
07/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,774

**Applicant(s)**

WHEELER ET AL.

**Examiner**

PEGAH PARVINI

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The rejection of claims 1, 4-9, 17-20, and 23-31 under Title 35 103(a) as being unpatentable over Wheeler as generally set forth in the previous Office Action is proper and stands.

The rejection of claim 13 under Title 35 103(a) as being unpatentable over Wheeler in view of Gross and further view of Verhoff et al. as generally set forth in the previous Office Action is proper and stands.

The rejection of claim 14 under Title 35 103(a) as being unpatentable over the combination of Wheeler, Gross, and Verhoff et al. and further in view of Garrett as generally set forth in the previous Office Action is proper and stands.

The rejection of claims 3-4, 8, 10-12, and 21-22 under Title 35 103(a) as being unpatentable over the combination of Wheeler in view of Verhoff et al. as generally set forth in the previous Office Action is proper and stands.

The rejection of claim 2 under Title 35 103(a) as being unpatentable over the combination of Wheeler in view of Gross and further, in view of Verhoff et al. as generally set forth in the previous Office Action is proper and stands.

The rejection of claim 2 under Title 35 103(a) as being unpatentable over the combination of Knox in view of Verhoff et al. as generally set forth in the previous Office Action is proper and stands.

The rejection of claim 15-16 under Title 35 103(a) as being unpatentable over the combination of Knox in view of Verhoff et al. and Sommer et al. as generally set forth in the previous Office Action is proper and stands.

#### ***Response to Amendment***

Applicants' amendment to claim 1, filed March 28, 2008, page 2, by eliminating "other than alcohol or esters" limitation is acknowledged. As such the rejection of said claim under Title 35 U.S.C. 112-second paragraph, as generally set forth in the previous Office Action is hereby withdrawn. However, said amendment is not sufficient to place the application in condition for allowance.

Applicants' amendment to claim 20, filed March 28, 2008, page 4, by correcting the misspelling is acknowledged. As such the objection to said claim as generally set forth in the previous Office Action is hereby withdrawn.

#### ***Response to Arguments***

Applicants' arguments filed March 28, 2008 have been fully considered but they are not persuasive.

Applicants have argued that nothing in Wheeler teaches or suggests milling metal powder in a non-aqueous, non-hydrocarbon, low volatility milling fluid that is both solvent and water miscible.

However, this is not found persuasive. The Examiner, respectfully, submits that Wheeler, as detailed in the previous Office Action, discloses the use of metal pigments in a coherent paste/composition which is non-dusting and substantially completely non-volatile, wherein said composition further contains compounds such as polyalkylene glycol derivatives which, as well settled in the art, have low volatility, and are both solvent and water miscible. Further, as noted in previous Office Action, said composition can be integrated with the preparation of metal flake paste by wet milling. In addition, claim 9 of the reference calls milling a powder.

With respect to the combined references of Wheeler, as the primary reference with other references, applicants do not argue the specific reasons for the combination.

In response to Applicants' argument that nothing in Knox or Verhoff et al. teaches or suggests milling metal powder in a non-aqueous, non-hydrocarbon, low volatility milling fluid that is both solvent and water miscible, it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the abstract of Knox calls milling a powder.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. P./  
Examiner, Art Unit 1793

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793